

Atty. Docket No. DE9-1999-0085US1
(590.027)

REMARKS

Please note the fact the November 27, 2003, fell on a Holiday when the Office was closed ensures this paper is timely filed as of today, November 28, 2003.

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

There are two objections to the disclosure. The first objection is that the log equation on page 8, line 3, is in improper form. This objection is not understood based on the information available to the undersigned. Clarification is respectfully requested. The second objection concerns the reference to "chapter 4". The paragraph in which this reference appears has been amended to replace the reference with "infra", which is intended to refer the reader to the "Detailed Description of the Invention" section of the application. Thus, it is believed the second objection has been obviated.

Claims 1-13 were pending in the instant application at the time of the outstanding Office Action. Claims 1 and 2 stand rejected under 35 U.S.C. 102(b) as being anticipated by Gadd. Claims 3-13 stand rejected under 35 U.S.C. 103(a) over Gadd in view of Pfiefer et al. (hereafter "Pfieffer") and in further view of alleged well known prior art. Claims 1, 11, and 13 are independent claims; the remaining claims are dependent claims. Reconsideration and withdrawal of the present rejections are hereby respectfully requested.

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Each of the independent claims refers to a "bit code". e.g., "coding the phonetic information in a bit code." (Claim 1) As discussed in the specification, in the present invention "the phonetic information is coded in a bit code which does not comprise any characters." (Page 5, lines 11-12) As further discussed in the specification, "[b]y representing the phonetic information as a sequence of bits, i.e., a binary value, the performance of a database search is significantly increased ..." (Page 9, lines 5-7) The Office admits, however, that "Gadd teaches a code that consists of a character followed by a sequence of numbers ..." (Office Action at 7) Thus, Gadd does not disclose the bit code of the present invention and as such does not anticipate the present invention.

A 35 U.S.C. 103(a) rejection requires that the combined cited references provide both the motivation to combine the references and an expectation of success. Not only is there no motivation to combine the references, no expectation of success, but actually combining the references would not produce the claimed invention. Thus, the claimed invention is patentable over the combined references and the state of the art.

The Office has admitted that neither of these references describe the invention but claims that combination of these teachings would be obvious to a person skilled in the art. This is not supported by the references. The rejection fails to take into account the absence of the claimed bit code, as that term is used in the application. In the absence of the bit code, there can be no expectation of the results obtained, that of increased performance of a database search.

The Office points to Section 5.3 of Pfeifer and the evaluation of the Phonix algorithm to support its position. (Office Action at 3) As stated in the description of the

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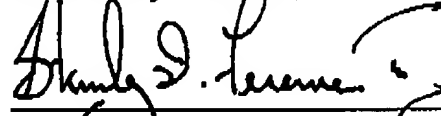
Phonix algorithm (Section 2.2), however, the Phonix code of a word is created "by replacing **every but the first** remaining letter by its numerical number ...". (emphasis added) Thus, even if there were a motivation for the combination of Gadd and Pfeifer, this combination does not teach or suggest the claimed invention.

In view of the foregoing, it is respectfully submitted that Claims 1-13 fully distinguish over the applied art and are thus in condition for allowance.

Applicant recognizes that the Office has considered the prior art made of record but not applied against the claims to have been not sufficiently relevant as to have been applied against the claims.

In summary, it is respectfully submitted that the instant application, including Claims 1-13, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. In the event, however, it appears the claims will not be allowed, the Office is invited to call the undersigned to discuss the claims prior to the issuance of a second Office Action.

Respectfully submitted,



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